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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/721,714	11/25/2003	Neil Warren Boaz	71360 (US03)	5757	
7590 06/22/2004			EXAMINER		
Michael J. Blake			KIFLE, BRUCK		
Eastman Chemical Company P.O. Box 511			ART UNIT	PAPER NUMBER	
Kingsport, TN	37662-5075	1624			

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application	No.	Applicant(s)				
Office Action Summary		10/721,714		BOAZ ET AL.				
		Examiner		Art Unit				
		Bruck Kifle,	Ph.D.	1624				
	of this communication app			orrespondence ad	ddress			
Period for Reply			EVELOE A MONTH	(a) 500M				
THE MAILING DATE OF - Extensions of time may be availal after SIX (6) MONTHS from the m - If the period for reply specified ab - If NO period for reply is specified - Evilure to reply within the set or e	TORY PERIOD FOR REPL THIS COMMUNICATION. The index the provisions of 37 CFR 1.1 and iling date of this communication. The iling date of this communication. The index is a replaced to the index	136(a). In no event, ly within the statutor will apply and will e	however, may a reply be ting ry minimum of thirty (30) day xpire SIX (6) MONTHS from tion to become ABANDONE	nely filed /s will be considered time the mailing date of this of D (35 U.S.C. § 133).	ely. communication.			
Status								
1) Responsive to com	munication(s) filed on 25 N	lovember 200	<u>3</u> .					
2a) ☐ This action is FINA	<u> </u>							
,	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is							
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.								
Disposition of Claims								
4) Claim(s) 29-37,42-47 and 51-54 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) Claim(s) is/are allowed. 6) Claim(s) 29-37,42-47 and 51-54 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or election requirement.								
Application Papers	1 Sector de la levelle e Francisco							
,	objected to by the Examino on is/are: a)☐ acc		l chiected to by the	Evaminer				
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).								
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.								
Priority under 35 U.S.C. § 1	10							
-		n neineitraundo	× 25 11 C C & 110/a) (d) or (f)				
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 								
Attachment(s)								
1) Notice of References Cited (F	PTO-892)	4) Interview Summary					
 2) Notice of Draftsperson's Pate 3) Information Disclosure Statem Paper No(s)/Mail Date 11/25/ 	nent(s) (PTO-1449 or PTO/SB/08	• •	Paper No(s)/Mail D Notice of Informal f Other:		[·] O-152)			

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Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 29, 33-37 and 42-47 drawn to compounds and methods of producing those compounds wherein n=0, classified in class 548, subclass 954+.
- II. Claims 29, 33-37 and 42-47, drawn to compounds and methods of producing those compounds wherein n=1, classified in class 540, subclass 362+.
- III. Claims 29-37, 42-47 and 51-54, drawn to compounds and methods of producing those compounds wherein n=2, classified in class 548, subclasses 413 and 570.
- IV. Claims 29, 33-37 and 42-47, drawn to compounds and methods of producing those compounds wherein n=3, classified in class 546, subclasses 22 and 248.
- V. Claims 29, 33-37 and 42-47, drawn to compounds and methods of producing those compounds wherein n=4, classified in class 540, subclasses 487 and 531.
- VI. Claims 29, 33-37 and 42-47, drawn to compounds and methods of producing those compounds wherein n=5, classified in class 540, subclass 451.

The inventions are distinct, each from the other because of the following reasons:

Groups I-VI are drawn to structurally dissimilar compounds. They are made and used independently. They are independent and distinct.

If, say compounds of Group I, were anticipated, applicants would not acquiesce in the rejection of Group II thereover or vice-versa. They are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the search

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required for Group I is not required for Groups II-VI, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Michael Blake on June 15, 2004 a provisional election was made with traverse to prosecute the invention of group III, compounds wherein n=2. Affirmation of this election must be made by applicant in replying to this Office action. Subject matter not falling under elected group III is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

Claims 29-37, 42-47 and 51-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) The phrase " C_4 to C_{20} heteroaryl" is indefinite because it is not known how many atoms are present, how many and what kind of heteroatoms are involved, what size ring is intended and how many rings are present. The " C_4 to C_{20} " indicates that only carbon atoms are present making the phrase " C_4 to C_{20} heteroaryl" self-contradictory Applicants need to rewrite this phrase as, for example, a "6-membered heteroaryl" and specify the kind and number of heteroatoms intended.

ii) The term "substituted", in the independent claims, without saying which substituents are intended is indefinite. One skilled in the art cannot say which substituents are permitted and which ones are not.

iii) Claim 51 improperly depends on claim 42 because claim 42 is drawn to a method of producing a compound but claim 51 is drawn to a compound (see also claims 52-54).

Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 571-272-0668. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Bruck Kifle, Ph.D. Primary Examiner

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BK

June 18, 2004